

S/N 10/656,070

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Remarks

This is in response to the final Office Action mailed on May 4, 2005. Claims 27, 29, 30, 32-48, and 50-59 remain pending, with claims 27, 30, 33, 36, 46, 48, 53, and 59 being independent. Reconsideration and allowance are respectfully requested for at least the following reasons.

I. Interview Summary

Applicants appreciate the courtesy extended by the Examiner to Applicants' representative, Robert A. Kalinsky, during the personal interview on May 26, 2005. During the interview, Moore et al., U.S. Patent No. 3,758,317 was discussed, as well as the secondary considerations presented in the Amendment filed on February 21, 2005. No agreement regarding the allowability of the claims was reached.

II. Claim Rejections - 35 U.S.C. § 103

In section 6 of the Action, claims 27, 29, 30, 32, 36-45, 48, 50, 52, 53, and 55-59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimek et al., U.S. Patent No. 5,941,237, in view of Moore et al., U.S. Patent No. 3,758,317. This rejection is respectfully traversed, and the correctness of the rejection is not conceded. Reconsideration is requested for at least the following reasons.

Applicants do not concede that there is any motivation to combine Shimek and Moore for at least the reasons provided in the Amendment filed on February 21, 2005. Applicants therefore respectfully do not concede that the rejection articulates a *prima facie* case of obviousness.

However, assuming for the purposes of this response only that the rejection does state a *prima facie* case of obviousness, it is respectfully suggested that the evidence of secondary considerations presented in the Amendment filed on February 21, 2005 has not been properly considered as evidence of nonobviousness.

A. The Proper Role for Secondary Consideration Evidence

An examiner must consider evidence of secondary considerations when determining the issue of obviousness. MPEP 716.01(a); Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538

S/N 10/656,070

PATENT

(Fed. Cir. 1983). The proper role for evidence such as secondary considerations is as follows:

Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a *prima facie* case was reached, not against the conclusion itself. In other words, each piece of rebuttal evidence should not be evaluated for its ability to knockdown the *prima facie* case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the *prima facie* case.

MPEP 716.01(d) (emphasis added) (citations omitted). There is no indication in the rejection that the secondary considerations presented in the Amendment filed on February 21, 2005 were evaluated as rebuttal evidence, rather than simply as evidence used to traverse whether or not a *prima facie* case of obviousness had been established. Consideration of these secondary considerations is respectfully requested.

B. Secondary Consideration - Long-Felt Need

One secondary consideration that must be considered when evidence of such is presented is a long-felt but unsolved need. Such evidence must include the following indicia: (i) recognized problem - an art recognized problem exists in the art for a long period of time without solution; (ii) problem not previously satisfied - long-felt need has not been satisfied by another before the invention; and (iii) invention solves problem - the invention must in fact satisfy the long-felt need. MPEP 716.04(I).

The Rule 132 declaration by David C. Lyons, executed on February 17, 2005 and filed with the Amendment on February 21, 2005 ("Lyons Rule 132 Declaration"), provides evidence of a long-felt but unsolved need. Specifically, the Lyons Rule 132 Declaration illustrates all of the indicia required by the law as summarized at MPEP 716.04(I):

- (i) recognized problem - there was a long-felt persistent need recognized in the fireplace industry for a burner or a fireplace including a burner panel that exhibited both structural integrity and malleability to allow for the burner panel to be manipulated after forming - see ¶¶ 4 and 7 of the Lyons Rule 132 Declaration;
- (ii) problem not previously satisfied - problems associated with prior molding techniques such as vacuum molding and casting did not solve the persistent need - see ¶¶ 5 and 6 of the Lyons Rule 132 Declaration; and

S/N 10/656,070

PATENT

- (iii) invention solves problem - burner panels including a compression molded material as recited in the rejected claims have greater strength and malleability and therefore squarely address the long-felt persistent need - see ¶¶ 8-10 of the Lyons Rule 132 Declaration.

It is respectfully requested that this evidence be considered in view of the contention in the rejection that the rejected claims are obvious over the combination of Shimek and Moore. When the evidence of "secondary considerations" is weighed against the factors relating to the establishment of an alleged *prima facie* case of obviousness, it is apparent that the rejected claims are not obvious in light of the combination of Shimek and Moore. In light of the intense and long-felt need in the industry, these claims cannot be said to be obvious over the recited patents, since any such "obvious" solution would have been implemented long ago in light of the above-described long-felt need - for example, Moore issued over three decades ago.

Reconsideration and allowance of claims 27, 29, 30, 32, 36-45, 48, 50, 52, 53, and 55-59 are therefore respectfully requested.

III. Allowable Subject Matter

In sections 8 and 9 of the Action, claims 33-35, 46, 47, 51, and 54 were noted as containing allowable subject matter. Applicants appreciate the Examiner's assistance in identifying allowable subject matter. All claims are in condition for allowance.

IV. Conclusion

The remarks set forth above provide certain arguments in support of the patentability of the pending claims. There may be other reasons that the pending claims are patentably distinct over the cited references, and the right to raise any such other reasons or arguments in the future is expressly reserved.

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S/N 10/656,070

PATENT

In view of the above amendments and remarks, Applicant respectfully requests examination and a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,
MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903
612.371.5271

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By: 
Name: Matthew A. Doscotch
Reg. No. 48,957
MAD/RAK